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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,938	02/07/2002	Robert John Mulligan	CM01562L	9852

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MOTOROLA, INC
INTELLECTUAL PROPERTY SECTION
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EXAMINER

CHIANG, JACK

ART UNIT PAPER NUMBER

2642

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071938

Applicant(s)

Mulligan ET AL.

Examiner

J. Chiang

Group Art Unit

2642

#5

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on interview dated on 8-19-04.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-25 is/are pending in the application.
- Of the above claim(s) 17-25 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-16 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to a housing having a substance that changes appearance, classified in class 379, subclass 433.01.
 - II. Claims 17-24, drawn to a housing have layers containing a fluid, classified in class 455, subclass 90.3.
 - III. Claims 25, drawn to a housing having layers containing fiber optics, classified in class 359, subclass 516.
2. The inventions are distinct, each from the other because:

Inventions Groups I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions involve Group I which requires a housing made from a specific substance. Group I does not require the combination of the layers and the fluid as it is required in Group II, nor the layers and fiber optics as required in Group III.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Ms. Randi Karpinia (Reg. No. 46148) on 07-01-04 a provisional election was made without traverse to prosecute the invention of **Group I, claims 1-16**. Affirmation of this election must be made by applicant in replying

to this Office action. **Claims 17-25** have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

CLAIMS

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 5, 7-13, 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Laurikka et al. (US 6608996).

Regarding claim 1, Laurikka shows a housing (7) comprising:

An outer visible surface (1) which is composed of an appearance changing substance (3a or 3b) response to an environmental stimulus (V).

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Regarding claim 7, Laurikka shows a housing (7) comprising:

An outer visible surface (1) having at least one shape element (see 2) composed of an appearance changing substance (3a or 3b) responsive to an environmental stimulus (V).

Regarding claims 2-3, 5, 8-13, 15, Laurikka shows:

The housing (7);

Internal components (circuitry, V, speaker, mike. etc.) which generates the environmental stimulus;

The stimulus is a combination of one or more stimuli selected from a group consisting of an acoustic, a thermal, an electrical, an electromagnetic, an olfactory, and a mechanical stimulus (col. 2, lines 31-38);

The substance is a combination of one or more substances selected from a group consisting of a color, a pattern, an illumination, a shape, and a sensory changing substance (col. 3, lines 25-53, col. 4, lines 45-54);

The shaped element becomes visible in response to the stimulus (i.e. 3a);

The shaped element becomes invisible in response to the stimulus (i.e. 3b);

At least one identification information selected from the group consisting of identification data, codes, patterns and images (col. 4, lines 45-54); and

An environment index gauge (col. 4, lines 55-67).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 6, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laurikka et al. (US 6608996) of Berry (US 5223958).

Regarding claims 4, 6, 14 and 16, Laurikka the appearance changing substance (3a or 3b) response to an environmental stimulus (V).

Laurikka differs from the claimed invention in that it is not a thermal stimulus, or a group consisting of a thermal, vibrating and haptic producing substance.


However, Berry teaches providing a resistive element or thermal/haptic producing substance (12) which can be energized by a thermal stimulus.

Hence, both Laurikka and Berry teach a concept of producing a color pattern on an object, both achieve substantially the same objective for providing enjoyment for the user. Therefore, it would have been obvious for one skilled to use Laurikka as it is, or to modify Laurikka by incorporate Berry's resistive element into Laurikka, such that to have a product which changes color/image to provide enjoyment and entertainment for the user (col. 1, lines 31-55 in Berry).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack Chiang
Primary Examiner
Art Unit 2642